

REMARKS

Claims **1-63** are pending in the application.

Claims **1-63** stand rejected.

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Claim **1** is amended.

Rejection of Claims under 35 U.S.C. §101(non-statutory subject matter)

Claims 50-63 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection. While the prior claims were directed to statutory subject matter, Applicants have previously chosen to amend Claims 50 to expedite prosecution. Claim 50 now recites, “generating, using a processor, a customer portal” and “presenting the customer portal, wherein the customer portal is configured to be displayed on a display coupled to the processor.”

The Final Office Action now further alleges, that “what is presented is the manipulation of data by a software system, so that the use of a computer, the machine, is merely trivial to the claimed purpose of the process.” The Final Office Action cites no authority for this notion that a computing machine is trivial. Applicants contest this notion of the triviality of the computer. Because the claims are tied to a specific machine, *i.e.*, a processor, without which Applicants are aware of no method for generating the recited customer portal, Applicants respectfully submit that the previous amendment overcomes the rejection of Claim 50 under 35 U.S.C. § 101. Further, as Claims 51-63

depend from and further patentably distinguish Claim 50, Applicants respectfully submit that the amendment to Claim 50 also overcomes the rejection of Claims 51-63 under 35 U.S.C. § 101. Applicants respectfully request that the Examiner withdraw the Final Office Action's rejection of Claims 50-63 under 35 U.S.C § 101 and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §101 (alleged class combinations)

Claims 21-35 stand rejected under 35 U.S.C. §101 for purportedly containing a combination of two statutory classes, namely a system and a process/method, thus making these claims allegedly statutorily indeterminate. Applicants respectfully traverse this rejection. As an initial matter, the Final Office Action has cited no authority for the conditions under which a claim is statutorily indeterminate and therefore subject to rejection. Without such authority, Applicants are unable to gauge, first, the propriety of the rejection itself, and second the nature of an appropriate response that might allay the concerns raised now for the first time in the Final Office Action. Applicants respectfully request citation to such authority.

Applicants further respectfully submit that the rejection is facially factually incorrect, because no combination of statutory classes is present in Claims 21-35. Though the Final Office Action does not point to specific offending language in Claims 21-35 that gives rise to the misapprehension of a method or process in the recitation of the claimed apparatus, Applicants believe that the rejection offered by the Final Office Action is predicated on an objection to the terms “business service method” and “workflow process.” Applicants respectfully submit that neither the term “business service method” nor the term “workflow process” describes a process or method as those

terms are understood in patent law, *i.e.* a set of steps. Instead, Applicants respectfully submit that the terms “business service method” (BSM) and “workflow process” are terms of art in the relevant arts. In the case at hand, in which a computing framework gives meaning and context to the limitations recited in the claims, one skilled in the art would readily recognize both the BSM and the workflow process as describing specific program constructs (*e.g.*, digital instructions).

As evidence of this “programming arts” understanding of the claim terms, Applicants respectfully submit that the concept of a business service method is described in Applicants’ specification at page 43, line 30. That text of page 43 states that “business service methods can be provided in a dynamic link library (DLL).” Thus, rather than the set of steps, which would be described as being performed by a DLL, Applicants respectfully submit that the BSM is a set of instructions that is capable of being provided in a DLL and executed by a processor. Similarly, a workflow process is described by page 43 as “having a configuration.” *See* Specification, pg. 43, line 30. As a set of steps, a legally cognizable method or process does not “have a configuration.” This confusion between the legal term of art “method” and the programming term of art, “BSM” as well as the legal term of art “process” and the programming term of art “workflow process,” is not a form of confusion that would not encumber the understanding achieved by one skilled in the art.

Thus, as no actual method or process is presented in the apparatus limitations of Claims 21-35, Applicants respectfully submit that the Final Office Action’s rejection of Claims 21-35 under 35 U.S.C. § 101 for allegedly combining statutory categories is both legally and factually improper. Applicants therefore request that the Examiner withdraw

the rejection of Claims 21-35 under 35 U.S.C. § 101 for allegedly combining statutory categories and Applicants request that a notice of allowance be issued for all pending Claims.

Rejection of Claims under 35 U.S.C. §112 (alleged lack of utility)

Claims 51-63 stand rejected under 35 U.S.C. §112, first paragraph, as failing to support the claimed invention by either a clearly asserted utility or a well-established utility. Applicants respectfully traverse this rejection. The Examiner has courteously clarified this rejection at page 15 of the Final Office Action, stating:

The MPEP states claims which fail to meet the requirements of 35 U.S.C. § 101 automatically fail to meet the requirements of 35 U.S.C. § 112-1st paragraph.

Office Action, p. 9. The Final Office Action having clarified the rejection under 35 U.S.C. § 112 as depending for its propriety on the rejection under 35 U.S.C § 101, Applicants respectfully submit that, having responded to the rejection of claims 50-63 under 35 U.S.C § 101, Applicants have also demonstrated that the Specification provides information sufficient to allow one of skill in the art to practice and use the claimed invention. Specifically, Applicants respectfully submit that the Applicants' arguments with respect to 35 U.S.C. § 101 have overcome the Final Office Action's rejection with respect to both 35 U.S.C. § 101 and the present rejection under 35 U.S.C. § 112, first paragraph. Applicants respectfully request that the Examiner withdraw the Final Office Action's rejections of Claims 50-63 under 35 U.S.C § 112, first paragraph, in light thereof.

Rejection of Claims under 35 U.S.C. §112 (alleged lack of enablement)

Claims 1-63 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement. Applicants respectfully traverse this rejection. The Final Office Action states that “A clear set of system and method steps leading to the processing of an order, critical or essential to the process of the invention, but not included in the claim(s) is not enabled by the disclosure... The lack of clarity is based on the conditional logic in the limitation of the independent claims and the lack of a potential result in a processed order...The preamble leads one to expect that these steps relate to a processed order.” See Office Action, page 4. Responsive to this concern, Applicants have amended each of independent Claims 1, 19, 36, and 50 to strike references to order processing in the preamble of the Claims. Applicants are aware of no law or rule restricting the recitation of conditional logic in a claim limitation, and the Final Office Action cites to none.

The Final Office Action further notes that “Ambiguity is caused to a large extent due to the use of programming language instead of standard business language in the specification and claims which the ordinary practitioner would use.” Applicants respectfully submit that any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. See M.P.E.P 2164.01. Applicants respectfully submit that, because claim 1 specifically recites “instructions on the computer-readable storage medium,” the language selected by

Applicants is entirely appropriate as a choice by which to provide sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Claim 19 recites a complex object on a computer-readable storage medium. Claim 36 recites instructions on a computer readable storage medium. Claim 50 recites “generating, using a processor.” For each of these limitations, the selected language is entirely appropriate to provide sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.

Applicants believe that the Final Office Action confuses the requirements of 35 U.S.C. § 112, first paragraph, with those of 35 U.S.C. §112, second paragraph, which relate to definiteness. Even then, Applicant’s respectfully submit that the Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether other language or modes of expression might be available. *See* M.P.E.P 2173.02. Applicants respectfully submit that the Final Office Action also notes that “The specification fails to contain a clear definition of the expression “business object” and “complex object.” Applicants respectfully disagree with the notion that a business object is not defined. Applicants’ specification states:

The business rules or concepts can be represented as business objects.
The business objects can be designed as configurable software
representations of the various business rules or concepts such as accounts,
contacts, opportunities, service requests, solutions, etc.

Specification, p.8, l. 26. Further, the phrase “complex object” occurs at 260 distinct points in the Specification, and Applicants submit that one skilled in the art would, in

light of the present specification, understand what is meant by a complex object. Further, Applicants respectfully note that independent Claim 1, which is also subject to the rejection, contains neither the phrase “complex object” nor the phrase “business object.” Applicants respectfully request that the Examiner withdraw the Final Office Action’s rejections of Claims 1-63 under 35 U.S.C § 112, first paragraph, and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §112 (alleged failure to set forth)

Claims 1-63 further stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to set forth the subject matter which the applicant(s) regard as their invention. The Final Office Action posits the following:

In that paper [the Specification filed December 17, 2001], applicant has stated the invention has the purpose of processing complex orders which include complex services and products, and this statement indicates that the invention is different from what is defined in the claim(s) because the independent claims do not include a limitation which indicates the processing of orders. ... Further, the limitations in the independent claims do not guarantee the processing of an order as stated in the preambles.

Office Action, p. 4. Applicants respectfully disagree. A rejection based on the failure to satisfy § 112, second paragraph is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). *Ergo*, the language of introduction in the Specification, which reads, “what is claimed is.”

In Claim 19, the claimed system functions by managing and transforming complex objects representing at least one of services, orders and/or quotes. With regard to Claim 36, an apparatus is claimed, wherein business service methods are used in conjunction with at least one of services, orders and/or quotes, which are represented by business objects. Finally, Claim 50 recites managing and transforming complex objects representing at least one of services, orders and/or quotes. For this reason, Applicants respectfully request that the Examiner withdraw the Final Office Action's rejection of Claims 1-63 under 35 U.S.C. § 112, second paragraph, and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §112 (alleged indefiniteness)

Claims 1-63 further stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Final Office Action posits:

For example, the limitation “at least one business service method performs a function associated with the selected option” in independent method claim 50 is vague and indefinite.” Independent Claims 1, 19 and 36 contain similar enabling limitations.

Office Action, p. 5. As an initial matter, Applicants respectfully assert that the Final Office Action's rejections under § 112 are improper, because they relate to claim breadth, rather than indefiniteness. As will be appreciated, if the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection [which refers to indefiniteness] would not be appropriate. *See* MPEP 706.03(d). The Examiner's concern appears to be that terminology could read on a breadth of multiple embodiments.

Breadth of a claim is not to be equated with indefiniteness. *See In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph. *See* MPEP 2173.04. More specifically, Applicants have previously amended Claim 50 and Claim 36 to further clarify the indicated limitations, now reciting “a selected option from among the plurality of user-selectable options,” which Applicants believe renders moot the rejections of Claim 50 and Claim 36. Applicants have likewise amended Claim 19 to recite “the transformation engine is further configured to generate the at least a portion of the complex object using the business object.”

Further, in the case of Claim 1, Applicants most respectfully disagree with the Examiner’s rejection. As will be appreciated, in reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). The Final Office Action points to the limitation “the at least one of the plurality of workflow processes is configured to invoke at least one of the plurality of business service methods to perform a function associated with the selected option.” Applicants have reviewed Claim 1 and find that each of the three recited limitations of Claim 1 that is preceded by a definite article is also supported by an antecedent within

Claim 1. Specifically, “the selected option,” which Applicants believe to be the basis of the Examiner’s rejection, is supported with an antecedent “a selected option” at line 12 of Claim 1.

Applicants respectfully submit that “the requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” *See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004). Applicants respectfully submit that each of the cited claims has a readily discernable meaning. For this reason, Applicants respectfully request that the Examiner withdraw the Final Office Action’s rejection of Claims 1-63 under 35 U.S.C § 112, second paragraph, and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §112 (alleged omitted steps)

Claims 1-63 stand rejected under 35 U.S.C. §112, second paragraph, as being incomplete for allegedly omitting essential steps, such omission amounting to a gap between the steps. Applicants respectfully traverse this rejection. The Final Office Action does not identify any step specifically omitted. Therefore, the Final Office Action proves no *prima facie* case of omission and provides no guidance as to how Applicants could, were they inclined to do so, satisfy the requirements of the Final Office Action. For this reason, Applicants respectfully request that the Examiner withdraw the

Final Office Action's rejection of Claims 1-63 under 35 U.S.C § 112, second paragraph, and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §112 (alleged metes and bounds)

Claims 1-63 stand rejected under 35 U.S.C. §112, second paragraph, because the metes and bounds in the claims are allegedly indefinite. Applicants respectfully traverse this rejection. As an initial matter, Applicants respectfully assert that the Final Office Action's rejections under § 112 are improper, because they relate to claim breadth, rather than indefiniteness. As will be appreciated, if the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection [which refers to indefiniteness] would not be appropriate. *See* MPEP 706.03(d). The Examiner's concern appears to be that terminology could read on a breadth of multiple embodiments. Breadth of a claim is not to be equated with indefiniteness. *See In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph. *See* MPEP 2173.04.

The Final Office Action notes that "Again, the cause of this problem is because software programming language makes up the content of the claims." Applicants respectfully submit that "the requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." *See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354,

1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004). Applicants respectfully submit that each of the cited claims has a readily discernable meaning. For this reason, Applicants respectfully request that the Examiner withdraw the Final Office Action's rejection of Claims 1-63 under 35 U.S.C § 112, second paragraph, and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §112 (alleged means plus function claims)

Claims 1-63 stand rejected under 35 U.S.C. §112, second paragraph, as failing the 112-6th paragraph test for means plus function claims. Applicants respectfully traverse this rejection, which Applicants note is offered for the first time on Final Office Action.

As an initial matter, Applicants respectfully traverse the propriety of finality in an Final Office Action containing a ground of rejection offered for the first time in the Final Office Action. Applicants respectfully submit that, under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. *See* MPEP 706.07(a). While Claim 36 was amended in the previous response to Office Action, the amendment did not alter the "means for" limitations of independent Claim 36 or its dependent Claims. Applicants therefore respectfully submit that the finality of the present Office Action is improper and respectfully request issuance of a new non-final office action.

Applicants respectfully submit that the Final Office Action's articulation of the "test" for means-plus-function (MPF) language is improper. The MPF "test" to which the Final Office Action alludes, is not an independent ground of rejection on the claims alone. The Final Office Action appears to demonstrate a belief that the so called "means plus function test," for which no authority is cited, requires that a claim is *per se* not allowable if the claim combines MPF language and structural limitations. *See* Final Office Action, p.5. Applicants are aware of no such *per se* test for allowability on the basis of MPF language and additional structure. Instead, the MPF test, as articulated in the MPEP, determines how the meaning of claims will be construed with respect to the supporting specification, rather than whether the claim by itself is *per se* allowable under 35 USC §112. *See* MPEP 2181. Applicants therefore respectfully submit that the rejection posited by the Final Office Action under 35 USC §112, 6th paragraph is improper. For this reason, Applicants respectfully request that the Examiner withdraw the Final Office Action's rejection of Claims 1-63 under 35 U.S.C § 112, sixth paragraph, and that a Notice of Allowance be issued for all pending claims.

Rejection of Claims under 35 U.S.C. §103

Claims 1-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Esposito* in view of *Wiecha* and Official Notice. While not conceding that the cited references qualify as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows. Applicants have reserved the right, for example, in a continuing application, to establish that the cited

references, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires, among other elements, that the references must teach or suggest all of the claim limitations. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Applicants have amended independent Claims 1, which now reads as follows:

A system comprising:
 a processor; and
 a computer-readable storage medium , wherein
 the processor and computer-readable storage medium are coupled to one another, and
 the computer-readable storage medium comprises
 a plurality of business service methods, wherein
 the plurality of business service methods are embodied as instructions encoded in the computer-readable storage medium,
 user interface instructions, wherein
 the user interface instructions are encoded in the computer-readable storage medium, and
 the user interface instructions are configured to cause said processor to
 generate a customer portal view comprising
 a list of products and services associated with an account,
 a list of quotes associated with the account,
 a list of orders associated with the account,
 and
 a plurality of user-selectable options, and
 receive input from a user, wherein
 the input comprises a selection of at least a selected option of the plurality of user-selectable options, and
 a plurality of workflow processes, wherein

the plurality of workflow processes are embodied as instructions on the computer-readable storage medium,
 at least one of the plurality of workflow processes is invoked in response to the selection of the at least the option of the plurality of user-selectable options,
 the at least one of the plurality of workflow processes is configured to cause a function to be performed by virtue of being configured to invoke at least one of the plurality of business service methods,
 the function is associated with the selected option, and
 the function is associated with provisioning at least one order from the list of orders.

By contrast, *Esposito* is directed to a method and system for conducting real time electronic commerce, and describes:

... a system for providing real-time notification of purchaser requirements in a heterogeneous network environment The heterogeneous network environment can include a public packet switched network, such as the Internet, and a wireless network, such as a plurality of pagers. Select embodiments include a plurality of wireless terminals in communication with the wireless network to receive real-time notification of a purchaser's requirements. At least one vendor computer is part of the system. The vendor computer has one or more databases for storing information about products and services in a product database, and a customer database, for storing information about customers. A plurality of client computers are part of the system. The client computers enable users to interact with the system to learn about and express interest in products and services.

See *Esposito*, Abstract. By further contrast, *Wiecha* is directed to a system for ordering items over computer network using an electronic catalog, and describes an approach in which:

Current corporate purchasing procedures are labor-intensive and therefore costly. The system enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and processing directly, by-passing both the normal paper

approvals and the manual verification of the order by the organization's Purchasing department. It achieves this by means of an electronic catalog accessible from the employee's own personal computer, and a computer network and associated services linking the enterprise to one or more suppliers.

See Wiecha, Abstract.

As an initial matter, Applicants respectfully submit that the newly added limitation of Claim 1, “the function is associated with provisioning at least one order from the list of orders,” is not taught or suggested by the combination of *Esposito* and *Wiecha*. For at least this reason, amended Claim 1 is allowable over the combination of *Esposito* and *Wiecha*.

More generally, the Final Office Action states that, basically, the Abstract of *Esposito* teaches the claimed invention, save for construction of the software for processing complex customer inquiries and purchase orders. *See* Office Action, p. 9. No specific citation, *e.g.*, page and line, to *Wiecha* is made at all with regard to independent Claims 1, 19, 36 and 50. With regard to the dependent claims, no citation whatsoever is made to *Esposito* or *Wiecha*, aside from a 6-line citation to *Esposito* purported to disclose the limitations of over 30 pages of claim language. Applicant is left to conclude that these claims are rejected simply for depending on a rejected claim. The Final Office Action merely picks a few of the claims, states that certain of such terminology such as that used in the claims is known (a point that Applicants do not concede), and then goes on in an attempt to fabricate some manner of skill in the art by making the conclusory statement that such are obvious as such terminology is known to users of systems from

Computer Associates, SAP, Baan and Oracle (once again, a point that Applicants do not concede).

Applicants therefore respectfully submit that the particular parts of the cited references that are relied upon in the Final Office Action have not been designated as nearly as practicable, and the pertinence of each reference has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). *See also* MPEP § 706.02(j). Moreover, the Final Office Action then proceeds to summarily make a bare assertion of obviousness of almost every limitation of the independent claims. Again, no mention is made of the references that would enable Applicants to ascertain which sections of the references the Final Office Action purports to map to the specific limitations of Applicants' claims. Applicants respectfully request that the Examiner, in the next office action, more thoroughly discharge the obligation that the particular parts of the cited references that are relied upon in the Final Office Action be designated as nearly as practicable, and the pertinence of each reference be clearly explained.

Further, the rejection is based upon a list of various items, some within the references and some which are not, that are loosely, if at all, connected to various elements in Applicants' claims without further support. Further still, the items recited in the references (such as they are) are generally unrelated to one another, resulting in inconsistency, and clearly have very little to do with Applicants' claims as recited. Applicants further object to the Examiner's various assertions of "inherency" in various elements in that such inherencies are either false or otherwise insufficient to sustain the rejection. Nevertheless, Applicants have made every effort to respond to the rejections outlined in the Final Office Action.

However, the Final Office Action does correctly state that *Esposito* fails to teach the construction of the software for processing complex customer inquiries and purchase orders. *See* Office Action, p. 9. For example, nowhere in *Esposito* is there shown, taught or suggested the generation of a customer portal. The Final Office Action points to figures 1-7 of *Esposito* as purported teaching of a customer portal. Of these, Figure 5-7 show generic information entry screens, but the Final Office Action makes no effort to map these various screens to the elements recited with respect to a customer portal, such as, e.g., a list of products and services associated with an account, a list of quotes associated with the account, a list of orders associated with the account, and a plurality of user-selectable options,” as recited.

Moreover, nowhere is there shown, taught or suggested the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. This is the case because *Esposito* teaches a “...a system for providing real-time notification of purchaser requirements in a heterogeneous network environment” *See Esposito*, Abstract. Thus, *Esposito* is directed to conducting real time electronic commerce, and is not equipped to deal with complex order processing, as in the claimed invention.

Wiecha is directed to a system for ordering items over a computer network using an electronic catalog. However, there is nothing taught by *Wiecha* that demonstrates anything more than simply a computer-based catalog system that allows a user to order items in the catalog electronically. This is just a system that enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and

processing directly, by-passing both the normal paper approvals and the manual verification of the order by the organization's Purchasing department.

By marked contrast, the claimed invention is directed, for example, to a method including the generation of a customer portal. Moreover, nowhere in the references is there shown, taught or suggested the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. Thus, neither *Esposito* nor *Wiecha*, taken alone or in permissible combination, shows, teaches or suggests (or has reason to do so) the use of the claimed invocations to address a user's need to perform certain functions as recited in Applicants' claims.

In addition to the foregoing infirmities, this lack of invocations results from the fact that neither *Esposito* nor *Wiecha*, taken separately or in any permissible combination, has need or recognition of technology such as that provided by the claimed invention. That neither reference teaches such technology thus comes as no surprise. In *Esposito*, the chosen approach is preferred in order to provide real-time notification of purchaser requirements in a heterogeneous network environment, and so the use of the claimed technology goes unrecognized and unappreciated. Given that the method is achieved through the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option, such functionality cannot be exercised in systems employing the design of *Esposito*. *Wiecha* fails to cure this infirmity of *Esposito*.

To wit, while *Esposito* may discuss a system which enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic

catalog displayed on a personal computer and submit an order for approval and processing, nothing is shown, taught or suggested with regard to the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. This is at least for the reason that *Esposito* is concerned with avoiding the traditional use of paper documents and used for Purchasing department approval. Given that *Wiecha* has no need of the claimed technology in achieving this end, one of skill in the art would not look to *Wiecha*'s disclosure for such teachings. In fact, given that *Wiecha* fails to demonstrate any sort of need for such technology, one would not expect one of skill in the art to look anywhere therefore. Thus, *Wiecha* provides neither a way to modify *Esposito*, nor does either reference demonstrate any sort of a need for such technology.

Thus, the Final Office Action does not establish the presence of these limitations in *Esposito* or *Wiecha*, taken alone or in permissible combination. As the Examiner appreciates, the burden is of supporting a case of obviousness lies with the Office, including whether the prior art references teach or suggest all of the claim limitations. See MPEP 706.02(j). For the reasons presented above, neither *Esposito* nor *Wiecha*, taken alone or in permissible combination, teach these limitations of claim 50, as well as the remaining independent claims.

In addition, Applicants also respectfully submit that the Final Office Action fails to satisfy the burden of factually supporting the alleged motivation to combine the two references. The duty of factually supporting the alleged motivation to combine may not be satisfied by engaging *impermissible* hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. Evidence must therefore be

provided to suggest the combination, and, as will be appreciated, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Final Office Action’s failure to meet this criteria is particularly evident with regard to the dependent claims, wherein neither reference is cited as teaching any recited limitation, nor is Official Notice taken thereof (which, Applicants maintain, would be inappropriate in any event).

In this regard, Applicants respectfully submit that *Esposito* and *Wiecha*, taken alone or in permissible combination, are not capable of presenting a system in which the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option, exist. Such technology is simply not shown, taught or suggested by either of these references. For the claimed invention, the ability to process complex orders in the manner discussed in the specification and recited in the claims, the combination of the use of *Esposito* and *Wiecha* is inadequate, particularly given that such is achieved through the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option.

This leads to the conclusion that not only do *Esposito* and *Wiecha* fail to show, teach or suggest such technology, but have no need to do so, because neither recognizes these benefits. Failing to appreciate these benefits, neither reference addresses the obstacles that exist to creating solutions, nor providing any such solutions, such as those provided by the claimed invention. Lacking such appreciation and teachings, one of skill in the art could not find any motivation to combine their disclosures, because neither

could be seen as lacking in this regard. Save for having the present disclosure to use as a blueprint, and so implying the use of hindsight, an obviously impermissible approach, which need not be dealt with here, the proposed combination is without motivation and support.

Further, the Final Office Action does not establish that such a combination of the teachings of these references would meet with success, as required. This comes as no surprise, as there is no way to combine these references to achieve the claimed invention, as demonstrated by the foregoing. Moreover, there is no teaching in the references, nor any extant in the skill in the art, which would provide the teachings necessary to successfully combine the disclosures of *Esposito* and *Wiecha*. Certainly, each of *Esposito* and *Wiecha* is directed to its own solution to its own problems, and is a self-sufficient and self-contained solution in that regard.

Were one of skill in the art to proceed regardless (a fruitless effort and one which Applicants do not concede in any event), the combination would still fail to teach the claimed invention, if only in regard to the claimed invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. At best, such a combination would yield a system for ordering items over computer network using an electronic catalog, which would provide such services using real time electronic commerce. Thus, the claimed invention, by its recognition of the need for complex order processing, is in no way made obvious (nor anticipated) by *Esposito* and/or *Wiecha*, taken alone or in any permissible combination.

The Final Office Action responds to this argument by asserting that,

Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "any judgment based on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Applicants may also argue that the combination of two or more references is "hindsight" because "express" motivation to combine the references is lacking. However, there is no requirement that an "express, written motivation to combine must appear in the prior art references before a finding of obviousness." See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 US:Q2d 1686, 1690 (Fed Cir. 2004). For example, motivation to combine prior art references may exist in the nature of the problem to be solved (*Ruiz* at 1276, 69 USPQ2d at 1690) or the knowledge of one of ordinary skill in the art (*National Steel Car v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d, 1641, 1656 (Fed. Cir. 2004)). See MPEP § 2143.01 <2100_2143_01.htm> for a discussion of proper motivation to combine the references. (First underlining added). In the instant case, the examiner believes that he has satisfied this standard.

See Office Action, p.16-17. Applicants respectfully disagree.

The Examiner correctly notes (at page 19) that the portion of *In re Kahn* cited by the *Ex Parte Catan* states that "Rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See Office Action, p.19. The Final Office Action's failure to meet this criteria is particularly evident with regard to the dependent claims, wherein neither reference is cited as teaching any recited limitation, nor is Official Notice taken thereof (which, Applicants maintain, would be inappropriate in any event). Applicants respectfully submit that analysis implies the citation of evidence, supported by reasoning. The assertion that "the steps represent generically obvious steps of the well known order placement and acceptance process, mixed with special terminology...were well known to purchasing and customer service professional users... Therefore it would have been

obvious...” is a naked assertion without adequate evidentiary support. Applicants respectfully submit that the Final Office Action has dismissed over fifty dependent claims without a single citation to any teaching of the two references on which the rejection is based and with only a passing mention of terms found in three of the over fifty dependent claims. Applicants respectfully submit that the dismissal of nearly thirty pages of claim language in less than one page of text from the Final Office Action is both conclusory and inadequate.

For these reasons, Applicants respectfully submit that the Final Office Action fails to present a *prima facie* case of obviousness of amended independent claims 1, 19, 36 and 50, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore respectfully submit that the Final Office Action’s rejection of Claims 1-63 under 35 U.S.C. §103 is unfounded and request that the Examiner withdraw the Final Office Action’s rejections. Applicants request that a Notice of Allowance be issued for all pending claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

I hereby certify that this correspondence is being submitted to the U.S. Patent and Trademark Office in accordance with 37 C.F.R. § 1.8 on 11/3/9 by being (a) transmitted via the USPTO's electronic filing system; or (b) transmitted by facsimile to _____; or (c) deposited with the U.S. Postal Service as First Class Mail in an envelope with sufficient postage addressed to: Mail Stop _____, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia, 22313-1450.

/ Stephen A. Mason /

11/3/9

Stephen A. Mason

Date

Respectfully submitted,

/ Stephen A. Mason /

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